

PRELIMINARY REMARKS
U.S. Appln. No. 09/360,951

would have suggested to one of ordinary skill in the art that the applied art should be modified in order to arrive at the claimed invention. It is essential that the Examiner find some motivation or suggestion to make the claimed invention in light of the applied art's teachings. The mere possibility that the applied art may be modified so as to arrive at the claimed invention does not render obvious the invention unless the applied art suggested the desirability of the proposed modification. The suggestion to modify must be "clear and particular."¹

Applying the law to the facts of the present case, one skilled in the art would not have been motivated to modify Petisce based on Szum's disclosure in order to achieve the claimed telecommunication element of independent Claim 1 or the claimed coating composition of independent Claim 6. There is simply no "clear and particular" suggestion within Szum to covalently bond at least one chromophore molecule to an oligomer.

Szum discloses covalently linking glass coupling, slip agent and radiation-curable moieties to an oligomer, but not a coloring agent to an oligomer, and much less the claimed chromophore molecule to an oligomer. Glass coupling, slip agent and radiation-curable moieties are in no way an equivalent of a coloring agent, much less the claimed chromophore molecule. Chromophore molecules do not share a close structural similarity with the disclosed glass coupling, slip agent and radiation-curable moieties. Chromophore molecules do not at all share a similar utility with the disclosed glass coupling, slip agent and radiation-curable moieties.

The conclusion that Szum provides the motivation to modify Petisce and achieve the claimed invention appears to stem from a mischaracterization of Szum's disclosure, as set forth in the paragraph bridging pages 3 and 4 of the Action. Therein, it is stated that "... one of ordinary skill in the art would have found it obvious to use the teachings of Szum et al of covalently bonding a coating to a '**molecule**'" (Emphasis added.)

¹ See, In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

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Szum, however, does not disclose the broad, general concept of covalently linking *any* molecule to the oligomer of a coating. For example, Szum does not disclose covalently linking each of a glass coupling, slip agent and radiation-curable moiety to the oligomer of a coating as a preferred embodiment of the general concept of covalently linking any molecule to the oligomer of a coating. Instead, Szum *only* discloses covalently linking glass coupling, slip agent and radiation-curable moieties to an oligomer.

To establish a *prima facie* case of obviousness, the applied references must provide those of ordinary skill in the art a reasonable expectation that the proposed modification to the applied art will succeed. Szum does not provide a broad, general expectation of success for covalently linking *any* molecule to the oligomer of a coating. From Petisce and Szum, a person of ordinary skill in the art can only reasonably predict success for covalently linking a glass coupling, slip agent or radiation-curable moiety to an oligomer.

In this regard, the chemical arts are well-known for being inherently unpredictable. Chromophore molecules do not share a close structural similarity with the disclosed glass coupling, slip agent and radiation-curable moieties. Chromophore molecules do not at all share a similar utility with the disclosed glass coupling, slip agent and radiation-curable moieties. Therefore, Petisce and Szum provide no basis for a person of ordinary skill in the art to have a reasonable expectation of success in covalently bonding at least one chromophore molecule to a coating, as claimed.

Finally, the clear and particular suggestion to achieve the claimed invention and the reasonable expectation of success must be found in the applied art, and cannot be based on the disclosure of the present application.² In the present case, the motivation to extrapolate Szum's disclosure from covalently linking glass coupling, slip agent and radiation-curable moieties to an oligomer to covalently bonding at least one chromophore molecule to an oligomer is provided only by the disclosure of the present application. Szum is silent on this particular issue.

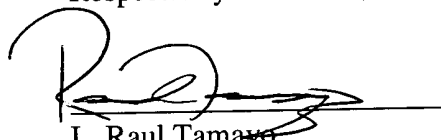
² See, MPEP § 2143 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373

CUSTOMER NUMBER

Date: November 3, 2003